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In re Application of
CLARKE et al.
U.S. Application No. 10/598,252
PCT No.: PCT/US05/05915
Int. Filing Date: 23 February 2005
Priority Date: 23 February 2004
Attorney Docket No.: 044170-0340
For: METHOD AND APPARATUS FOR
FOLDING AN AIR BAG FOR STOWING
IN AN AIR BAG MODULE

DECISION ON PETITION

This decision is issued in response to applicants' "Petition under 37 CFR 1.47(a)" filed 02 November 2007 to accept the application without the signature of joint inventor, Humberto Hernandez and Andres Rojero.

BACKGROUND

On 23 February 2005, applicants filed international application PCT/US05/05915 which claimed a priority date of 23 February 2004. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 23 August 2006.

On 22 August 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an application data sheet; and a copy of the international application.

On 03 April 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 02 November 2007, applicants filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or

cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor.

Applicants have submitted the appropriate petition fee. Item (1) is therefore satisfied.

As to item (2), section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

a. Humberto Hernandez

A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, drawings and oath/declaration) to Humberto Hernandez. The declaration of Deanna Mejia states that a package was mailed, via FedEx, to Humberto Hernandez on July 9, 2007. Delivery confirmation has been provided. However, it is unclear from the present petition and accompanying documents whether Humberto Hernandez has been presented with a complete copy of the application papers as required. The mailing of the declaration and power of attorney are not considered a complete copy of the application.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Humberto Hernandez, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

b. Andres Rojero

It appears that petitioner is asserting that Andres Rojero cannot be found or reached after diligent effort. A review of the present petition reveals that petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Andres Rojero. The declaration of Deanna Mejia states that a package was mailed, via FedEx, to Andres Rojero on July 9, 2007. The FedEx tracking report indicates that the package was "undeliverable." However, the declaration fails to include evidence of any other attempts made to locate the nonsigning inventor. The single mailing of the papers to the nonsigning inventor's last known address does not constitute a "diligent" effort to locate the inventor. Applicants must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate Andres Rojero.

Regarding item (3), applicants have provided the last known address of the nonsigning inventors (Humberto Hernandez and Andres Rojero). Accordingly, item (3) is therefore satisfied.

As to item (4), an oath or declaration by each 37 CFR 1.47(a) applicant on his or her

own behalf and behalf of the nonsigning joint inventor has been included with the present petition. However, the declaration filed 02 November 2007 is not acceptable under 37 CFR 1.497. Specifically, the declaration is executed by James GARVIN, whereas the international application lists the inventor as James GAVIN. As stated MPEP 201.03,

"a request under 37 CFR 1.48 will not be required: (B) Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required."

Applicants have not provided an explanation of the typographical or transliteration error of the name of the fifth inventor. Further, the declaration executed James Garvin includes an alteration to his name. (See MPEP §605.04(a) and 37 CFR 1.52(c)) Any changes made in ink in the application or oath prior to signing should be initiated and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or non-dated alteration were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a). Therefore, a newly executed declaration by James Garvin is required.


For the reasons stated above, it would not be appropriate to accept the application without the signature of Humberto Hernandez and Andres Rojero under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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Refund Ref:
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01 FC:1617
 02 FC:1463
 03 FC:1255

130.00 OP
 200.00 OP
 2230.00 OP

Refund Total: \$620.00

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